Remarks

The amendment to claim 1

Examiner will immediately see that the amendment is fully supported by the Specification as filed. The claim as now amended makes it clear that upon receipt of the comment from the second physician, the medical information specialist "determin[es] whether any continuing medical education is to result". Since there will be a continuing medical education credit if the medical information specialist so determines, the claim as amended satisfies the "usefulness" requirement.

Traversal of the rejection of claims 1 and 2 under 35 U.S.C. 103

As set forth in MPEP 2142, in order for an examiner to make a rejection of a claim for obviousness under 35 U.S.C. 103, the examiner must establish a *prima facie* case of obviousness. A necessary element of the *prima facie* case is that the references that are being combined disclose all of the limitations of the claim under rejection. The combination of the Telemedicine and Remote references does not show all of the limitations of claim 1, and consequently, the rejection is without basis.

The failure of the Telemedicine reference to show the limitations of claim 1

Telemedicine is a 1996 survey of the new possibilities that the improvements in information processing and telecommunications which were taking place in the 1990's offered the medical profession. Among the possibilities considered in the survey are "the transmission of health care information and information on education and administrative services" (p.1, col. 1, bottom) and the use of "two-way, interactive telecommunications video systems to examine patients from remote locations, to facilitate medical consultations, and to train health care professionals" (p.1, col. 2, bottom). Further discussed are the uses of the technology for rural hospitals and health providers (page 3, col. 1, top) and the University of Washington's use of telecommunications technology to overcome distance with regard to medical education, delivery of health care, and conferences among providers (page 4, col. 2, middle). There is also a discussion of the difference for licensing purposes between using telecommunications technology to provide care directly to a patient from an out of state location and using the technology for consultations between doctors. (page 14, col. 2, top) Implications for medical practice of

live and store-and-forward telecommunications interactions are discussed at page 19, col. 1, beginning in the second paragraph.

As might be expected from the nature of Telemedicine, Examiner's application of the reference to the limitations of claim 1 does not bear close scrutiny.

The preamble of claim 1 sets forth a particular environment in which the continuing medical education credit is provided:

- The CME is provided to the first physician "for a consultation between the first physician and a second physician", i.e., the *consultation* provides the learning experience for the first physician for which the CME is provided;
- The consultation is "conducted through an intermediary"; the use of the words "conducted through" are meant to indicate that, as set forth in the body of the claim, the intermediary does *more* than set up a connection between the first and second physicians.

Telemedicine discloses that telecommunications technology may be used for consultations between physicians, but discloses *nothing whatever* about such consultations taking place via *any* intermediary, let alone one that is connected by a telecommunications system to both the first and second physicians or about it being possible to obtain CME credit on the basis of a consultation.

The environment set up by the preamble is referred to repeatedly in the steps of the method, and thus must be taken into account in interpreting the claim. Thus, the "comment" of the first method step is "made with regard to the consultation" and "received via the telecommunications system from the second physician in the intermediary". Further, in the second step, the comment is provided "to a medical information specialist in the intermediary" and the medical information specialist "determin[es] whether any continuing medical education credit is to result from the consultation represented by the comment" and "if continuing medical education credit is to result, recording the resulting continuing medical education credit in a database accessible from the intermediary".

Detailed rebuttal of Examiner's arguments in her Office action of 12/18/2006

Beginning at the bottom of page 4, Examiner finds the step of "receiving a comment made with regard to the consultation via the telecommunications system from the second physician in the intermediary" disclosed at Telemedicine, page 1, col. 2, paragraph 2 to page 2 col. 1, par. 1; page 3, col. 1, par. 4; page 4, col. 2, par. 4; page 14, col.1, pars. 3-4; page 18, col.2, par. 2; page 19, col. 1, pars. 2-3, page 22, col. 1, par. 4 to col. 2, par. 2. What is disclosed at these locations is the following:

- page 1, col. 2, paragraph 2 to page 2 col. 1: The cited location is an overview of what can be done using telecommunications in medicine; included in the list is "to facilitate medical consultations".
- page 3, col. 1, par. 4: The cited location describes how improved telecommunications can give better access to patient data and provide research databases of that information.
- page 4, col. 2, par. 4: The cited location describes how telecommunications technology can be used to deliver medical school classes and health care can be delivered over distance, and that conferences can be successfully conducted where the participants are not located in the same area.
- page 14, col.1, pars. 3-4: The cited location describes how new imaging and telecommunications technologies can be used to exchange medical information.
- page 18, col.2, par. 2: the cited location describes how the speed of data transfer has to take the bandwidth of the transfer medium and the amount and type of data to be transferred.
- page 19, col. 1, pars. 2-3: the cited location distinguishes between "live" interactions and "store and forward" interactions and indicates that which is used will depend on the functional requirements of the interaction.
- page 22, col. 1, par. 4 to col. 2, par. 2: The cited location describes the use of TVs as home health monitoring system, software that permits exchange of stored video images and medical records, and MEDNET, which is a network for exchanging "administrative, clinical, and analytical health care information"

The foregoing locations demonstrate that telecommunications may be used in consultations among physicians; however, neither the individual locations cited above nor their combination discloses the claimed

> receiving a comment made with regard to the consultation [, the consultation being conducted through the intermediary], via the telecommunications system in the intermediary

For the disclosure of the second method step,

> providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist determining whether any continuing medical education credit is to result from the consultation represented by the comment and if continuing medical education credit is to result, recording the resulting continuing medical education credit in a database accessible from the intermediary.

Examiner again cites Telemedicine, page 1, col. 2, paragraph 2 to page 2 col. 1; page 3, col. 1, par. 4; page 4, col. 2, par. 4; page 14, col.1, pars. 3-4; page 19, col. 1, pars. 2-3; and page 22, col. 1, par. 4 to col. 2, par. 2. There is simply no mention at any of the cited locations of anything like the "medical information specialist" or the specialist's role in determining whether the first physician will receive CMEC credit for the consultation represented by the comment and recording the CMEC credit if the specialist determines that the physician should receive it.

As Examiner herself admits at page 5, par. 3, Telemedicine fails to disclose the intermediary; Examiner cites the Remote reference for the disclosure of the intermediary; however, as just pointed out, Telemedicine further fails to disclose any of the activity of the medical information specialist in the intermediary with regard to the comment and the CMEC. That being the case, the combination of Telemedicine with Remote does not show all of the limitations of claim 1 and Examiner has not made her *prima facie* case of obviousness.

Additionally, Examiner's attempt to read Remote onto the limitations of claim 1 no more bears close scrutiny than did her attempt to read Telemedicine on those limitations. As

Examiner points out, Remote does set forth the following at page 168, col. 1, par. 3 (Examiner cites to par. 2, but par. 3 must be meant):

> Physicians in remote areas who use the MCG system for consultations are given credit hours toward meeting their continuing medical education (CME) requirements

Examiner then takes MCG (Medical College of Georgia) to be the claim 1's "intermediary". There is however no indication whatever here or anywhere else in the reference that the consultation is conducted "through the [Medical College of Georgia]", as is required by the claim's preamble or that "the comment [is provided] to a medical information specialist in the [Medical College of Georgia]" or that there is a medical education specialist in the Medical College of Georgia who "determines whether any continuing medical education credit is to result from the consultation".

More specifically, the cited locations in Remote in addition to page 168, col.1, par. 3 disclose the following:

- page 164, col. 1, par. 1: the cited location discusses how both rural physicians and specialists in academic medical centers can benefit from telemedicine services. Benefits for the rural physicians include "the educational experience of interacting with and learning from specialists" and "having access to formal continuing medical education courses".
- page 170, col.1, bottom-col. 2, top discloses the Mayo Clinic's use of telemedicine to integrate remote sites including to doctors at Pine Ridge Indian Reservation. Included in the uses of telemedicine were the provision of consulting and continuing medical education.

None of these locations disclose anything beyond the disclosure of page 168, col. 1, par. 3; consequently, Remote does not disclose the claimed intermediary, and for that reason as well, the combination of Telemedicine and Remote does not show all of the limitations of claim 1.

Claim 2

Claim 2 is of course patentable because it is dependent from a patentable claim; it is, however, further patentable in its own right over the combination of Telemedicine and

Remote. Important limitations of claim 2 in the present context are that what is retrieved is "instructional material relevant to the comment and the consultation", that the database is "accessible from the intermediary" (claim 1) and that it is the medical information specialist who retrieves the instructional material. With regard to the latter limitation, Examiner cites Telemedicine at a number of locations that have already been discussed with regard to the second step of claim 1's method, namely page 3, col., 1, par. 4 to col. 2, par. 1, page 14, col. 1, par. 2 to col. 2, par. 1, page 10, col. 1, par. 2 to col. 2, par. 2, and page 22, col. 1, par. 4 to col. 2, par. 2. The rejection of claim 2 additionally cites page 8, col. 2, par. 1; page 9, col. 1, par.3; and page 15, col. 1, par. 4 to col. 2, par. 1. As already pointed out with regard to the discussion of the second method step of claim 1, none of the previously-cited locations disclose anything whatever about the medical information specialist; the same is the case with the newly-cited locations:

- page 8, col. 2, par. 1: the cited location discusses the need to educate the users of telemedicine applications about the applications.
- page 9, col.1, par. 3: the cited location discusses how the use of telemedicine by managed care organizations might jeopardize the patient-physician relationship.
- page 15, col. 1, par. 4 to col. 2, par. 2 discusses the licensure problems involved in using telemedicine to practice remotely.

Because Telemedicine does not disclose the limitation that the instructional material is retrieved by the medical information specialist, claim 2 is patentable in its own right over the references.

Conclusion

Applicants have demonstrated that the amendment to claim 1 adds no new matter and that the claim as amended overcomes the rejection of claims 1 and 2 under 35 U.S.C. 101. Applicants have further traversed the rejections under 35 U.S.C. 103. Applicants have consequently been completely responsive to the Office action of 12/18/2006, as required by 37 C.F.R. 1.111(b) and respectfully request that Examiner continue with her examination of the claims as amended, as provided by 37 C.F.R. 1.111(a). No fees are believed to be required for this amendment; should any be, please charge them to deposit account number 501315.

Respectfully submitted,

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